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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/707,445	11/06/2000	Gilbert M. Aust	A31-2047RE	9717

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EXAMINER

THALER, MICHAEL H

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 04/24/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/707,445

Applicant(s)

Aust et al.

Examiner

Michael Thaler

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3731



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.138 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7, 10, and 11 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1, 2, and 4 is/are allowed.
- 6) ☒ Claim(s) 3, 5-7, 10, and 11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language pr visional application has been received.
- 15) ☐ Acknowledgement is made of a claim for d mestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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The Final Rejection mailed Oct. 8, 2002 is hereby withdrawn and replaced by the following Office Action. The period for response is restarted to begin with the mailing of this Office Action.

Claims 3, 5-7, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan et al. (5,285,795). As to claims 3 and 5, Ryan et al. show a surgical system comprising stem section (e.g. 98 or 24) extending from a handle (at the proximal end of stem section 98 or 24), cutting tool 22 including a cutter 40, a hollow articulated section 78 a drive shaft 90, 86 having a flexible portion 86 and actuator means 110, 112, 94, 96 including first and second elongated elements 94, 96. Ryan et al., in this embodiment, disclose the cutter and drive shaft as being longitudinally reciprocal rather than rotatable. However, it is well known in the surgical instrument art that surgical cutters within elongated tubular members may be either rotatable or longitudinally reciprocal. In fact, Ryan et al. discloses in col. 1, lines 7-15 that a related application, which is incorporated therein by reference, includes a rotary cutting blade. One of the self-evident advantages of a rotatable cutter over a longitudinally reciprocal cutter is that the cutter and drive shaft does not undergo abrupt changes in directions at each stroke which could wear out parts. Making the Ryan et al. cutter and drive shaft rotatable rather than longitudinally reciprocal would have been

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obvious for these reasons. Although Ryan et al. disclose using the actuator to bend the cannula 24 while the probe is not present therein, and then inserting the probe into the bent cannula, the Ryan et al. apparatus, with no modification in structure, is inherently capable of being used in a different manner, i.e., by first inserting the probe into the cannula and then using actuator to bend the cannula 24 with the probe therein. Since the claims are drawn to the apparatus rather than the method of using the apparatus, the rejection is proper. Alternatively, it certainly would have been obvious to bend the Ryan et al. cannula 24 and probe therein by the actuator in order to fine tune the orientation of the probe in the body if the cannula and probe were not initially oriented perfectly in the body. As to claims 6, 7, 10 and 11, the combination of members 78, 102 as well as the unlabeled ring shaped attachment member at the distal end of the first and second elongated elements 94, 96 seen in figure 4 is considered to be the claimed "hollow articulated section". Note that first and second elongated elements 94, 96 extend through this articulated section, as claimed, since they are located radially within the confines of the outer diameter of the unlabeled ring shaped attachment member described above. As to claims 5, 7, 11, although the passage 48 of Ryan et al. is disclosed as being used to conduct fluid and tissue from the cutter to the handle, this passage, with no modification, is inherently capable of conducting fluid in the

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opposite direction, from the handle towards the cutter by for example connecting the proximal end of the passage to a source of irrigating fluid. Since the source of irrigating fluid is not part of the claimed combination, it is not necessary for the prior art to show this feature.

Claims 1, 2 and 4 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (703) 308-2981. The examiner can normally be reached Monday to Friday.

mht  
April 22, 2003



MICHAEL THALER  
PRIMARY EXAMINER  
ART UNIT 3731